

REMARKS

Claims 17-43 are now pending in the present application. Reconsideration is respectfully requested in light of the amendments to the claims and the following remarks. The allowability of claims 25, 28, 29 and 42 is gratefully acknowledged.

OBJECTIONS TO THE CLAIMS:

Claims 24 and 29 were objected to for minor informalities. These informalities have been corrected in accordance with the suggestions made by the Examiner.

CLAIM REJECTIONS UNDER 35 U.S.C. §112:

Claims 29 and 33-34 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 29 and 33 have each been amended to delete the word "inwardly" therefrom. As is illustrated in the drawings, the alignment tab extends from an inner surface of the cover member and Applicants believe that the confusion is eliminated by deleting the above-referenced term.

CLAIM REJECTIONS UNDER 35 U.S.C. §103:

Claims 17-24, 26, 27, 29-38, 40, 41, and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over Spisak, U.S. Patent No. 4,316,638 in view of Wieczorek et al., U.S. Patent No. 6,238,007. Independent claim 17 defines a wheel cover assembly that includes, among other things, a cover member having at least one boss extending inwardly from an inner surface, and at least one retention clip having a body with at least one aperture extending therethrough that frictionally receives the at least one boss of the cover member therein, thereby coupling the at least one retention clip to the cover member.

It is well established law that obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 U.S.P.Q. 929, 932, 933 (Fed. Cir. 1984). In other words, "[T]he Examiner must show reasons that the skilled artisan, *confronted with the same problems as the inventor and with no knowledge of the claimed invention*, would select the elements from the cited

prior art references for combination in the manner claimed.” *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed Cir. 1998) (emphasis added). Moreover, the mere fact that prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992) (citing *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)).

Applicants submit that there is no motivation within the art as cited by the Examiner for combining that which is taught therein. The motivation of Spisak to include the use of at least one boss extending inwardly from an inner surface for receiving at least one aperture of a retaining clip comprising tabs as taught by Wieczorek et al. in order to achieve securing ornamentation to a wheel using a single element, thus reducing the assembly time is not presented in any of the art as cited by the Examiner. While there are numerous ways for attaching wheel ornaments to associated vehicle wheels, this particular motivation would render obvious nearly any combination that would in fact ease or increase the speed of assembly.

Moreover, such a motivation would not be in itself enough to allow such a combination without picking-and-choosing elements from each reference. Specifically, Spisak discloses a wheel trim assembly that includes retainer elements that are slidably received within guide means in the form of openings formed through the sidewall of the cap so that the retainer elements project radially outward of the cap. As is clearly illustrated in Fig. 3 of Spisak, the retainer elements are each coupled to the cap by a single mechanical fastener thereby allowing proper clearance for the retainer elements to be placed within the cap prior to being secured thereto. Should the mechanical fastener as disclosed by Spisak simply be replaced with a boss and aperture, it is unclear as to how such an assembly would be made in light of the requirement of extending the retainer elements through the associated openings while still providing adequate clearance. Further, Wieczorek et al. discloses a retaining article for a wheel ornamentation that includes a plurality of leg members that cooperate with one another

to surround and engage the lug nut of an associated wheel assembly. It is noted that such an arrangement requires the complete encapsulation of the lug nuts as associated with the wheel by the cap, as opposed to allowing the cover member to be configured such that the lugs of an associated wheel assembly remain exposed when the cover member is coupled to the vehicle wheel assembly, as is defined in claim 17. Selecting only the openings as disclosed by Wieczorek et al. would therefore require an improper picking-and-choosing of a single element from that which is disclosed. Therefore, neither Spisak nor Wieczorek et al. teach, motivate or suggest that which is defined in independent claim 17, either singularly or held in combination.

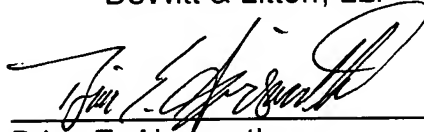
Claims 18-29 depend from claim 17 which is in condition for allowance, which is noted above, and are therefore also in condition for allowance.

Claim 30 defines a retention clip for a vehicle wheel cover member that comprises a body portion having an aperture extending therethrough and adapted to frictionally receive the boss of a vehicle wheel cover member therein, thereby coupling the retention clip to the cover member. As claim 30 defines similar elements to those discussed above with respect to independent claim 17, claim 30 is also allowable in view of the cited art. As claim 31-43 depend from claim 31 which is in condition for allowance, as noted herein, these claims are also in condition for allowance.

Accordingly, claims 17-43 are now in condition for allowance, a Notice of Allowability is earnestly solicited.

Respectfully submitted,

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